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Attorney Docket No. 03-039

REMARKS

The applicants appreciate the acknowledgement of the claim for priority under section 119 and the notice that the certified copy of the priority document has been received.

Also, the applicants acknowledge receipt of the initialed copy of the form PTO-1449.

Claims 1-18 are pending. Claims 13-17 have been withdrawn. The applicants respectfully request reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claims 1-12 were rejected under 35 USC 103(a) as being unpatentable over allegedly admitted prior art FIG. 4 ("APA") in view of GB Pat. No. 2,265,760, Matsumoto ("Matsumoto"). Claim 1 has been amended for clarification; support for the amendment is located in the specification as filed, for example FIG. 3, and page 11, line 25 to page 12, line 23. Insofar as the rejection can be applied to the claims as amended, the rejection is respectfully traversed for reasons including the following, which are provided by way of example.

Independent claim 1 as amended recites in combination, for example, "an electrically conductive membrane installed on the electrically insulative membrane and including a component hole pattern in a position corresponding to the at least one component hole pattern of the electrically insulative membrane to surround said one of the high frequency signal source and the mounting component, wherein the electrically conductive membrane is electrically connected with the ground pattern through the connection hole pattern." Because the component hole patterns of the electrically insulative membrane surround one of the high frequency signal source and mounting component, the component hole patterns of the electrically conductive membrane also surround the same high frequency signal source or mounting component.

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As explained in the specification, page 12, lines 18-25, "by virtue of the component hole pattern 72a of the electrically conductive membrane 72, surrounding the mounted component, the electrically conductive membrane 72 functions as a ground pattern in a manner that is extended not linearly but flatly so as to wholly cover the control circuit 321a. More specifically, it can achieve larger grounding area than one in which the ground patterns are wired linearly, thereby achieving the higher grounding performance."

The examiner argues that the invention as claimed is obvious over a combination of APA and Matsumoto.

To properly reject a claimed invention, the examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness with respect to a claimed invention, all the claim limitations must be taught or suggested by the prior art reference (or references when combined). *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Furthermore, the teaching or suggestion to make the claimed combination and a reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). The examiner bears the burden of establishing this *prima facie* case. *In re Deuel*, 34 U.S.P.Q.2d 1210, 1214 (Fed. Cir. 1995). Where, as here, the examiner fails to establish a *prima facie* case of obviousness, then without more the applicant is entitled to grant of patent. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

The applicants provide herein a selection of some examples of limitations in the claims which are neither taught nor suggested by APA. The Office Action admits that "APA does not

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disclose the printed circuit board comprising an electrical conductive membrane formed on an insulative membrane and connected to a ground pattern through a connection hole pattern."

(Office Action, page 2.)

Recognizing that APA fails to teach and/or suggest the invention as claimed, Matsumoto is cited to remedy the deficiencies. Nevertheless, Matsumoto fails to remedy such deficiencies.

For example, neither APA (FIG. 4) nor Matsumoto teach or suggest the electrically conductive membrane installed on the electrically insulative membrane with the component hole pattern corresponding to the component hole pattern of the electrically insulative membrane to surround the high frequency signal source or the mounting component, where the electrically conductive membrane is electrically connected with the ground pattern through the connection hole pattern. The examiner admits that APA (FIG. 4) fails to teach or suggest the electrically conductive membrane as recited.

Matsumoto, to the contrary, does not have a conductive membrane with component hole pattern corresponding to that of the electrically insulative membrane. Moreover, in Matsumoto, the component hole pattern of the electrically conductive membrane (9) does not surround the high frequency signal source or mounting component.

Hence, APA and Matsumoto, alone or in combination, fail to teach or suggest the combination of features recited in independent claim 1, when considered as a whole.

Furthermore, APA and/or Matsumoto operate in a fundamentally different way than the claimed invention. Specifically, neither APA nor Matsumoto teach or even suggest, let alone disclose, anything about surrounding the mounted component so that the electrically conductive membrane functions as a ground pattern extended in a flat manner, to achieve a larger grounding area in comparison to structures in which the ground patterns are wired linearly. The Office

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Action cites Matsumoto as disclosing this limitation, however, Matsumoto is clearly deficient considering the invention as claimed as a whole. Consequently, the proposed combination fails to teach or suggest the claimed invention.

With respect to the rejected dependent claims, applicant respectfully submits that these claims are allowable not only by virtue of their dependency from independent claim 1, but also because of additional features they recite in combination.

New claim 18 has been added, and is deemed to be patentable for reasons including its dependency from claim 1. Support for new claim 18 is located in the specification as filed, for example, FIG. 3, and page 12, lines 5-25.

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of simplicity, applicants have provided examples of why the claims described above are distinguishable over the cited prior art.

In view of the foregoing, the applicants submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

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If there are any problems with the payment of fees, please charge any underpayments and credit any overpayments to Deposit Account No. 50-1147.

Respectfully submitted,



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